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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,535	01/27/1999	ROBERT LINLEY MUIR	2663/FBR	6165

26304 7590 06/16/2003

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EXAMINER

BROCKETTI, JULIE K

ART UNIT	PAPER NUMBER
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3713

DATE MAILED: 06/16/2003

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/238,535

Applicant(s)

MUIR, ROBERT LINLEY

Examiner

Julie K Brockett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 11, 12 and 19-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Newly submitted claims 19-55 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

- I. Claims 9, 10, 13-18, drawn to a distributed gaming system with a server, classified in class 463, subclass 40.
- II. Claims 19-55, drawn to a game system comprising one or more program processing components etc., classified in class 700, subclass 91.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the distributed gaming system does not require the specific program processing components or game platforms of the gaming system of invention II. The subcombination has separate utility such as being a gaming system with a specific processing program and does not have to be a distributed system. The Examiner also notes that many of the claims recite

limitations that were restricted out in the first office action and Applicant is now trying to insert the same material into new claims.

Since applicant has received an action on the merits for the originally presented invention, i.e. claims 9, 10 and 13-18, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-55 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 9, 10 and 13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 9, 10 and 13 claim the limitation of "platform code". "Code", i.e. software or a computer program, is descriptive material *per se* and is not statutory because it is not capable of causing functional change in the computer. See *e.g.*, *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. See MPEP 2106 IV (B).

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any

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person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9, 10 and 13-18 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 9 states "platform code for executing the at least one of the functional modules." Claim 10 states "for execution by the consoles' platform code." Claim 13 states "platform code located in the server adapted to separate..." Platform code cannot execute nor separate anything. A computer must be involved performing the execution of the code. This is not clear in the claims and therefore they are not enabled.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14-16 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 states "a combination module". This is unclear. It is not understood if the combination is a mixture of many modules or if the combination is the various game outcomes that can occur.

Claim 15 states “wherein the server stores a plurality of functional modules for the same function for one or more of the games.” It is unclear as to what is meant by the phrase “for the same function”.

Claims 16 and 18 state, “...wherein the function is a currency symbol”. The word “function” implies an action. A currency symbol is not an action; consequently, the phrase above as written is confusing.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 10 and 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tarr et al., U.S. Patent No. 5,935,004 in view of Acres, U.S. Patent No. 6,319,125 B1. Tarr et al. discloses a distributed gaming system. The system uses a server and a game platform interface (See Tarr et al. Fig. 1). A plurality of games are stored on the server and are arranged to interact only via the platform interface (See Tarr et al. col. 5 lines 55-60; col. 6 lines 41-47). The system uses a plurality of consoles (Fig. 1). It is inherent that each console includes platform code for executing the software programs. Platform code is also located in the server in order to separate the game software programs and

for transferring the programs to a console. The server stores the software and files that perform the same functions for the games (See Tarr et al. col. 6 lines 53-61). Tarr et al. lacks in specifically disclosing separating the game software into separate functional modules.

Acres teaches of a gaming device in which the software controlling the device is broken up into various functional modules. Each module consists of one or more procedures or functions. Programs are broken up into modules when they address more than one issue. The modules cover a wide variety of areas including game play, graphics and audio. The game outcome or bonus outcome is stored in a module. It would have been obvious at the time the invention was made to store the game outcome on a server so that it would be more difficult for a player to tamper with and change the selected game outcome. By having the outcome stored on a server, more security is provided to the system. The graphics/audio files or other functional module is distributed to one or more consoles for execution by the computer system in the console. Acres teaches of credit and jackpot modules. Both of these areas deal with money; consequently, it would have been obvious to display a currency symbol to a player in order for the player to easily determine how much money they are betting or winning (See Acres col. 51 lines 2-63). It would have been obvious at the time the invention was made to separate the software programs in the invention of Tarr et al. into a plurality of functional modules. To easily understand and alter programs they must be broken up

into small components such as modules. This helps the software designer change and fix problems with the program more easily. If a long program was written, they demand a high level of concentration and areas of unrelated levels of concern must be separated. Good programming style uses modules, which are easier to change, fix and replace.

Response to Amendment

It has been noted that claims 19-55 have been added. It is also noted that claim 23 is dependant on claim 3 which was withdrawn from consideration. Furthermore, claims 43 and 53 are listed twice in the copy of the claims showing the changes made.

Response to Arguments

Applicant's arguments filed May 18, 2003 have been fully considered but they are not persuasive.

The Applicant contends that claims 9, 10 and 13 have been rewritten so that there is no longer an issue about non-statutory subject matter. The Examiner could find no evidence in the Amendment that the claims have been amended in any way to overcome either the 35 U.S.C. 101 rejections or the 35 U.S.C. 112 rejections. The original claims stand as originally presented and are once again rejected for the reasons above.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a game system having program processing components having a user interface console, in which each program processing component is an instance of many logically different gaming program processing platforms and a set of game programs having a game program capable of running on each gaming program processing platform and in which the program has specific Gaming Application Programming Interfaces configured to run on a different one of gaming program processing platforms) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that the limitations that the Applicant attempts to argue over the prior art of record are only recited in claims 19-55 which are withdrawn from consideration based on applying to a second invention.

Citation of Relevant Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1. The Electrical Engineering Handbook.

--The Electrical Engineering Handbook clearly shows that the use of modules is well known throughout the art of computer programming.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie K Brockett whose telephone number is 703-308-7306. The examiner can normally be reached on M-Th 7:30-5:00.

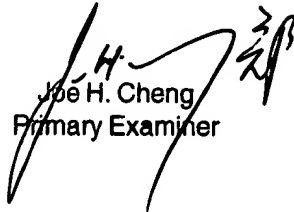
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike O'Neill "Acting SPE" can be reached on 703-308-1148. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is 703-306-5648.


JB
June 12, 2003


Joe H. Cheng
Primary Examiner